

REMARKS

Claims 1-32 are pending in the application. Claims 1-3, 15-16, 20-25 and 28-32 stand rejected. Claims 1-22 and 30 are objected to.

Applicant gratefully acknowledges Examiner's indication that claims 4-14, 17-19 and 26-27 comprise allowable subject matter and would be allowable if rewritten as suggested in the Office Action.

By the above amendment, claims 1, 15, 17, 19, and 30 have been amended.

Reconsideration of the claim rejections and objections is respectfully requested in view of the above amendments and following remarks.

Claim Objections

Claims 1-22 and 30 are objected to for the reasons set forth on page 2 of the Office Action. The specific objections to claims 1, 15, 19 and 30 have been addressed by the above amendments. Therefore, withdrawal of the claim objections is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 1-3, 15-16, 20-25 and 28-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,233,235 to Burke et al. in view of U.S. Patent No. 6,289,085 to Miyashita et al, for the reasons set forth on pages 3-5 of the Office Action.

It is respectfully submitted that the above claim rejections are legally deficient because under 35 U.S.C. § 103(c), the Miyashita reference is not available as prior art against the claimed invention. More specifically, under amended provision 35 U.S.C. §103(c), commonly assigned applications that are available as prior art only under 35 U.S.C. §102(e), (f) or (g) are no longer

applicable as prior art to the claimed invention in an obviousness rejection. In particular, 35

U.S.C. §103(c) was amended to recite:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person.

(Emphasis added). See also 1233 OG 55-56 (April 11, 2000), which describes guidelines to implement amended §103(c).

Here, the provisions of 35 U.S.C. 103(c) are applicable to disqualify the Miyashita reference as prior art against the claimed inventions for the following reasons.

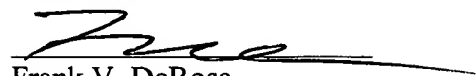
First, Miyashita is available as prior art to the present application *only* under 35 U.S.C. §102(e). Indeed, the Miyashita patent was issued on September 11, 2001, which is *after* the effective filing date of Applicant's current application, November 1, 2000.

Secondly, Applicant's current application was filed *after* the effective date of November 29, 1999.

Thirdly, for purposes of *common ownership*, the current application and the Miyashita patent were, at the time the invention of the current application was made, owned by the same entity, International Business Machines Corporation.

Therefore, the amended provision 103(c) is applicable and the Miyashita reference is disqualified as prior art against the claimed inventions and cannot be used support the current claim rejections under 35 U.S.C. § 103(a). Accordingly, the claim rejections under 35 U.S.C. 103(a) are *legally deficient on their face and, consequently, must be withdrawn*. Accordingly, withdrawal of the claim rejections under 35 U.S.C. § 103 is respectfully requested.

Respectfully submitted,



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